

Arguments/Remarks

Claims 1-4 and 9-10 were pending in the instant application. Claim 1 has been amended. Support for the amendments to claim 1 can be found, at least, in examples 78-80, located on pages 123-124 of the specification as originally filed. No new matter has been added.

Applicants note with appreciation that the Examiner has withdrawn the rejection of claims 1-4 under 35 U.S.C. 112, first paragraph for failing to particularly point out and claim the subject matter which the applicant regards as his invention.

Claim Rejections – 35 USC § 102

Blumberg

The Examiner has maintained the rejection of claims 1 and 9 under 35 USC 102(b) as being anticipated by Blumberg *et al.*, (U.S. Patent No. 7,098,212).

According to the Examiner, "Blumberg *et al.*, disclose a series of compounds which anticipate the current claims." In particular the Examiner directs the Applicants attention to column 48, compound 1-[4(4-fluoro-benzyl)-(2R,5S)-2,5-dimethyl-piperazin-1-yl]-3-(2-hydroxy-4-methylphenyl)propan-1-one, wherein the position corresponding to R₁ in the instant claims is X-R₁₀, wherein X is O and R₁₀ is hydrogen.

Applicants respectfully disagree, however solely in the interest of expediting prosecution of the instant application Applicants have amended the definition of R₁ to: -X-R₁₀, -X-(R₁₀)₂ or -NR₁₁R₁₂; wherein X is a linker having 1, 2, 3 or 4 atoms independently selected from N, C or S.

Therefore, the instant claims are not anticipated by Blumberg *et al.*, wherein X is O. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Ohtaka

The Examiner has maintained the rejection of claims 1, 4 and 9 under 35 USC 102(b) as being anticipated by Ohtaka *et al.*, (U.S. Patent No. 4,742,062). In particular, the Examiner is of the opinion that the definition of R₁ in the pending claims includes halo and that intermediate compounds in columns 3 and 4 of Ohtaka *et al.*, read on the current claims.

Applicants respectfully traverse. As stated above R₁ has been amended to -X-R₁₀, -X-(R₁₀)₂ or -NR₁₁R₁₂; wherein X is a linker having 1, 2, 3 or 4 atoms independently selected from N, C or S.

Therefore, the instant claims are not directed to compounds wherein R₁ is halogen and not anticipated by Ohtaka *et al.* In view of foregoing, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections – 35 USC § 112

Claims 1-4 and 9-10 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. In particular, the examiner is of the opinion that the proviso recited in claim 1, “compounds wherein X is –O-C-C-C- are excluded,” is not supported by the original disclosure and thus, is considered new matter.

Without acquiescing to the validity of the Examiner’s argument and solely in the interest of expediting prosecution of the instant application, Applicants have amended claim 1 by removing the proviso, “compounds wherein X is –O-C-C-C- are excluded.” As such, this rejection under 35 USC 112, first paragraph, is moot and should be withdrawn.

Conclusion

Applicants respectfully request that the amendments and remarks made herein be entered and made of record in the file history of the present application. Withdrawal of the Examiner’s rejection and a notice of allowance are requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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